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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,378	02/18/2004	Eric Boone	P8222.10	2766
27581	7590	02/16/2006	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN . 55432-9924			SZMAL, BRIAN SCOTT	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 02/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/781,378

Applicant(s)

BOONE ET AL.

Examiner

Brian Szmaj

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9-17-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 3-8, 10-16, 18-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6,464,629 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims disclose the subject matter as claimed in the issued claim, albeit in a broader language.

3. Claims 4, 11 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 46 of U.S. Patent No. 6,464,629 B1 in view of Boone et al (6,740,028 B2). Boone et al ('629) discloses a spring bias in the clamp assembly, but fail to disclose dual compression springs. Boone et al ('028) discloses the spring bias in the clamp assembly is attained through the use of dual

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compression springs. It would have been obvious to one of ordinary skill in the art to claim the use of dual compression springs based on the specifications of the current application as well as the parent applications.

Claim Rejections - 35 USC § 102 & 35 USC § 103

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-24 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Taylor et al (6,394,951 B1).

Taylor et al disclose surgical instruments and means for stabilizing a beating heart and further disclose an arm having a proximal end and a distal end; a cable extending through the arm, the cable having distal and proximal ends; a tissue contacting

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assembly connected to the distal end of the cable, the tissue contacting assembly having a rotatable condition in which the assembly is free to rotate relative to the arm, and a locked condition in which the assembly is locked in a position relative to the arm, the tissue contacting assembly having at least one surface for engaging tissue; a cable tensioning mechanism connected to the proximal end of the cable and engaging the proximal end of the arm to pull the cable relative to the arm when the cable is tensioned to change the tissue contacting assembly from the rotatable condition to the locked condition; a clamp coupled to the proximal end of the arm for fixing the arm to a retractor, clamp comprising a mount and a jaw defining a dovetail-shaped groove for receiving a retractor element, the jaw being spring biased relative to the mount to clamp the retractor element within the dovetail-shaped groove and being movable against the bias to release the retractor element, and a manually operable cam mechanism for locking the jaw relative to the mount; the jaw is attached to the mount by a pin and a groove thus allowing the jaw to slide back and forth relative to the mount; the clamp is adapted to be fixed to retractor elements of varying width; the arm comprises a plurality of links; the arm has an articulating condition in which the links are free to move relative to one another and a locked condition in which the links are locked relative to one another; the tissue-contacting assembly comprises first and second paddles each having means for engaging tissue; and a retractor. See Column 23, lines 33-35; Column 31, lines 21-67; Column 32, lines 1-8; Column 35, lines 12-67; Column 36, lines 1-5; Column 44, lines 24-65; Column 45, lines 11-67; and Column 46, lines 1-31; and Figures 53 and 81.

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At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to utilize dual compression springs in the clamp since the Applicant has not disclosed that the dual compression springs is used for a particular purpose, provides an advantage or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the clamping mechanism of Taylor et al and the claimed clamping mechanism to perform equally well with either the clamping assembly of Taylor et al or the claimed clamping assembly because both clamping mechanisms perform the same function of allowing the assembly to slide along the retractor and lock in the desired location.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Szmaj whose telephone number is (571) 272-4733. The examiner can normally be reached on Monday-Friday, with second Fridays off.

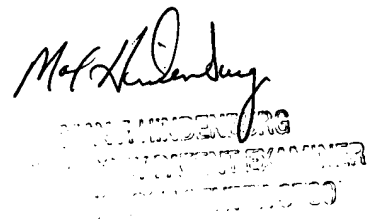
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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